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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,845	01/12/2001	Pierre D. Grondin	PG16044P0310US	1863

32116 7590 03/25/2005

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,845	Applicant(s) GRONDIN ET AL.	
	Examiner Jenna-Leigh Befumo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Amendment submitted on December 20, 2004, has been entered. Claim 2 has been cancelled. Claims 1, 6, 8, and 10 have been amended. Therefore, the pending claims are 1 and 3 – 13.

2. The amendment is sufficient to overcome the objection to claim 10 since the viscosity range has been amended to be within the range recited in claim 1. Further, the 35 USC 112 1st rejection is also withdrawn since the viscosity range in claim 10 has been amended so that it is no longer new matter.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 3 – 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McAmish et al. (6,191,221) in view of Ferrar et al. (EP 0 570 215 A2) for the reasons of record.

The limitations added to claim 1 were previously present in a dependent claim and were addressed by the previous rejection.

5. Claims 1 and 3 – 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrar et al. in view of Ray et al. (5,762,643) for the reasons of record.

The limitations added to claim 1 were previously present in a dependent claim and were addressed by the previous rejection.

Response to Arguments

6. Applicant's arguments filed December 20, 2004 have been fully considered but they are not persuasive. The applicant argues that the rejection based on McAmish et al. in view of Ferrar et al. fails to teach having the desirable combination of physical properties disclosed in the present invention (response, page 7). However, it has been held that failure of those skilled in the art to contemporaneously recognize that a property, function, or ingredient is present in the invention a prior art reference does not preclude a rejection. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999). In other words, if a reference, or combination of references, has the same physical structure as the claimed invention than any properties, functions, or ingredients in the claimed invention would also be present in the prior art invention. As set forth in the previous Office Action, the claimed strength, moisture vapor transmission, and liquid impermeability properties are presumed to be present in the combination of prior art references. Thus, the burden has shifted to the Applicant to provide evidence that the properties are not present in the prior art materials. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. Arguments of counsel cannot take the place of evidence. *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Further, the applicant argues that McAmish et al. teaches away from using spunbond fabrics with the claimed basis weights because McAmish et al. discloses that the basis weight of the fabric is not critical to the invention (response, pages 7 – 8). However, the full teaching of McAmish et al. states “since the film resides as a layer on one side of the fabric, the basis weight of the fabric is not critical, and depends on the end use of the product” (column 3, lines 58 – 60). In other words, McAmish et al. is disclosing that a spunbond fabric of any basis weight could be

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used in the invention without destroying the inventive concept which is a breathable film composite. Further, the teaching that the basis weight would be chosen based on the end use of fabric suggests that it would be within the level of ordinary skill to choose the basis weight of the fabric by knowing how the composite is going to be used or looking to the prior art to learn what basis weights are used in similar products or similar structures.

The applicant further argues that the two references could not be combined since McAmish et al. is drawn to an extrusion coated fabric while Ferrar et al. discloses that the spunbond fabric is spot bonded to the fabric layer (response, pages 8 – 9). However, the teachings relied on in Ferrar et al. are to general spunbonded fabrics and not limited to just spot bonded composite fabrics. In fact the section referenced in the rejection is describing only spunbond layers in general and teaches that the fabrics are used in a wide range of basis weights from 10 to 200 g/m² (column 1, lines 47 – 50). Ferrar et al. also adds that a preferred basis weight range is between 30 and 90 g/m² because this weight range produces fabrics that provide a significant contribution to the desirable strength and stability of the laminate (column 1, lines 51 – column 2, line 3). Thus, Ferrar et al. explicitly provides reason to use a similar weight range as the applicant and does disclose this weight range provides improved strength and stability. Further, there is no reason why the intermittent bond structure in the fabric composite would preclude one of ordinary skill in the art from relating the teachings of the spunbond layer in Ferrar et al. to other film composites with spunbond layers. Thus, the rejection is maintained.

Finally, the applicant argues that the use of a polypropylene having a viscosity between 6 and 16 MFR would require more than mere optimization because the melt flow rate produces increased strength over similar spunbond polypropylene fabrics made on the same equipment

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with a typical 35 MFR polypropylene resin (response, pages 9 – 10). Thus, it is the applicant's position that the claimed viscosity range produces unexpected results. However, the applicant has not provided sufficient evidence to establish that the claimed viscosity polymer would produce increased strength properties when compared to more commonly used viscosity ranges. First, it is noted that the table in the specification which compares typical SBPP to SBPP made with 8 MFR PP on the same machinery does not actually provide data for all the properties and therefore cannot be relied on to show any improvements.

Second, the disclosure fails to clearly set forth what is used to make the typical SBPP fabric and the actual processing conditions for the typical SBPP fabric and the high strength SBPP fabric of the invention. Hence, it is unclear if the difference in properties is actually due to the difference in viscosities or the difference in processing conditions. In fact, the applicant discloses, in Example 1, that the processing conditions were selected to produce the desired strip tensile strength. This would suggest not only that it is the processing conditions themselves and not the viscosity of the polymer that determines the properties of the final product, but also that one of ordinary skill in the art would be able to select the process conditions for various viscosity polymers, including typical PP polymers, to produce the same strength as the claimed invention.

It is noted that the applicant provides no detail at all in the disclosure as to how one would choose the processing conditions to produce the desired strength properties. By this omission, the applicant is conceding that choosing processing conditions to produce desired properties in the final product is within the general skill level of the art. Since one of ordinary skill would know how to choose the processing condition to produce a desired strength in the final product, it can be reasonably concluded that one of ordinary skill could also choose the

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viscosity of the polymer based on the properties desired in the final product. Additionally, spunbond polypropylene fabrics could only be produced from polymers within a known viscosity range since the polymer viscosity would reach a point which is too thick or too viscous to actually produce a spunbond fabric. The fact that choosing a viscosity would only require one of ordinary skill in the art to choose from a known range of viscosities is further evidenced by various prior art references that teach a range of viscosities that can be used to produce polypropylene spunbond fabrics. For example, US 5,366,786 discloses a range of 12 MFR or greater, US 5,482,765 discloses a range of 9 – 100 MFR, and US 5,540,976 discloses a range of 10 – 50 MFR. Thus, it is known the range of viscosities which can be used to produce polypropylene spunbond fabrics and one of ordinary skill in the art would only need to choose a desired viscosity. Therefore, the rejection is maintained.

Further, the patentability of a product is based on the structure of the final product itself and not the process to make the product or the properties of the beginning or intermediate product. In other words, if the same final product, having the same structural limitations and physical properties, can be produced by a different method or with a different intermediate or starting material then the claim is unpatentable even though a different starting material or process was used to produce the final product. Thus, if the properties of the end product are controlled by the processing conditions themselves and can be produced by using polymers with viscosities outside of the claimed range, then the viscosity of the starting material would not be relevant to the structural limitations of the final product and is not entitled to be given patentable weight in the product claim.

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7. The applicant also argues that the rejection based on Ferrar et al. in view of Ray et al. should be withdrawn since Ferrar et al. fails to teach the claimed basis weight range (response, page 11). However, as set forth above not only does Ferrar et al. teach using spunbond fabrics between 10 and 200 g/m², which overlaps the claimed range, but Ferrar et al. also teaches that using fabrics with a basis weight between 60 and 90 g/m² would produce a laminate with improved strength and stability properties.

Also, the applicant argues that the references fail to teach the claimed properties of the present invention (response, page 11). As discussed above, the prior art does not need to teach specific properties if those properties are believed to be present in the references or combination of references, because the products have the same structure as the claimed invention. In the prior Office Action, it was set forth that the claimed properties are believed to be present in the invention produced by the combination of Ferrar et al. and Ray et al. Thus, the applicant must provide evidence to show that the properties are not present in the prior art. And the arguments provided by the applicant are not sufficient evidence. Therefore, the rejection is maintained.

Finally, the applicant argues that choosing a viscosity range would not simply be discovering an optimum or workable range that only involves routine skill in the art (response, page 11). With respect to the viscosity limitation in the claimed invention, as set forth above, choosing a viscosity range from within a known range would only require one of ordinary skill to discover an optimum or workable range based on the processing conditions or desired end product. Further, the applicant has not provided sufficient evidence to show that the viscosity would be related to the improved properties in the final product and that the final product would

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actually have a different structure than other polypropylene spunbond fabrics made from polymers having a viscosity outside the claimed range. Therefore, the rejection is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo
March 20, 2005

